

REMARKS

Claims 51-66 are all the claims pending in the application. Claim 67 has been canceled.

Entry of the above amendment is respectfully requested.

Initially, since the Examiner is new to this application, Applicants respectfully request a personal interview to discuss the Declaration evidence of record and the distinctions between the present invention and Suzuki.

Also, Applicants note that the Examiner has not returned an initialed and signed copy of the PTO-1449 form filed March 13, 2003. Accordingly, Applicants request that the Examiner consider the disclosed information and return a copy of the initialed and signed PTO-1449 form with the next communication from the PTO.

I. Response to Rejection of Claims 51-67 under 35 C.F.R. § 112, second paragraph

On pages 2-3 of the Office Action, claims 51-67 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner's rejections are as follows.

A. Claim 67 recites the limitation "described in claim 46". There is insufficient antecedent basis for this limitation in the claim.

As indicated above, claim 67 has been canceled, and therefore it is respectfully submitted that the rejection of claim 67 is moot.

B. The term “strongly” in claim 51 (1st line of second to last paragraph) is a relative term which renders the claim indefinite. The term “strongly” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Applicants respectfully submit that the specification does provide a standard for ascertaining the requisite degree of strength. At page 12, lines 9 to 19, the present specification discloses that strong mixing expresses manual mixing using a mortar, mechanical mixing using a container fixed-type mixer such as a universal mixer, a ribbon mixer, an automatic mortar or a ball mill, or mechanical mixing using a high-speed mixer, a powerful automatic mixer, etc. Accordingly, Applicants could argue that one of skill in the art would be reasonably apprised of the scope of the invention.

However, in order to expedite prosecution, Applicants have amended claim 51 to recite the various methods of strong mechanical mixing.

In view of the above, it is respectfully submitted that the rejection is overcome, and withdrawal of the rejection of claim 51 is respectfully requested.

C. The term “analogs” in claims 59, 61, and 63 is vague and indefinite, as the metes and bounds of this claim are unascertainable. What are analogs of these compounds? The specification does not define this phrase and one of ordinary skill in the art would not be apprised of its meaning.

Applicants have deleted the term “analogs” and have placed the affected drugs in plural form for consistency with the rest of the claim. Accordingly, withdrawal of the rejection of claims 59, 61 and 63 is respectfully requested.

D. The phrase “insulin-like growth factors” in claims 59 and 63 is vague and indefinite because the claim includes elements not actually disclosed (those encompassed by “like”), thereby rendering the scope of the claim unascertainable. The Examiner indicates that the pages from *Products for Life Science Research* have not been received.

As noted in the previous responses, it is respectfully submitted that the phrase “insulin-like growth factor” is a term of art that is well-known by one of skill in the art. Accordingly, Applicants re-submit herewith pages from *Products for Life Science Research* to support Applicants’ position that the phrase “insulin-like growth factor” is a term of art. Accordingly, it is submitted that one of skill in the art would understand the meaning and scope of the claims.

E. The phrase “calcitonin gene-related peptides” in claims 59 and 63 is vague and indefinite. What compounds are encompassed by these claims? Chemically, what does the term “related” refer to? The specification does not define this phrase and one of ordinary skill in the art would not be apprised of its meaning.

It is respectfully submitted that the phrase “calcitonin gene-related peptide” is a term of art that is well-known by one of skill in the art. Accordingly, Applicants submit herewith an abstract of “Calcitonin Gene-Related Peptide Inhibits Nonadrenergic Noncholinergic Contraction of Guinea Pig Distal Colon”, *Jpn. J.*

Pharmacol. 73(3), 255-257 (1997) to support Applicants' position that the phrase "calcitonin gene-related peptide" is a term of art. Accordingly, it is submitted that one of skill in the art would understand the meaning and scope of the claims.

In view of the above, withdrawal of the foregoing rejections is respectfully requested.

II. Response to rejection of Claims 51-57, 59-67 under 35 U.S.C. § 103(a)

On pages 3-5 of the Office Action, claims 51-57 and 59-67 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki.

Basically, the Examiner's position is substantially the same as that set forth in the previous Office Actions.

Applicants respectfully respond as follows.

On pages 6-8 of the Office Action, the Examiner asserts that Applicants' argument that the composition of the present invention is different from that of Suzuki and that the present invention provides unexpected results is not persuasive because the Declaration does not provide comparative data between the present invention and Suzuki.

However, Applicants have submitted three (3) Declarations in this case containing data comparing the composition of the present invention to the composition of Suzuki. For example, in the Declaration filed March 14, 2001, Applicants compared the present invention (Example 74) to a composition corresponding to the composition of Suzuki (Comparative Example 67). Not only did

Applicants submit a plasma profile comparing the two (2) compositions, but also Applicants calculated the Cmax and AUC for the compositions, which were also included in the Declaration of March 14, 2001.

In addition, in the Declaration filed October 22, 2001, Applicants compared compositions of present invention prepared by the processes of the present invention to a composition obtained by the processes disclosed by Suzuki. For example, Applicants compared Examples 75, 76 and 77 to Comparative Example 68 (made by a process disclosed by Suzuki), which had a smaller AUC and lower Cmax compared to Examples 75, 76 and 77.

Therefore, comparative data between the present invention and the composition of Suzuki have been submitted.

In addition, the Examiner asserts that Suzuki provides motivation for one of ordinary skill in the art to obtain a composition comprising a drug, a water-insoluble base, and a water-soluble base, wherein the drug is dispersed more on the water-insoluble base material. Also, the Examiner asserts that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

It is respectfully submitted that obtaining a composition comprising a drug, a water-insoluble base, and a water-soluble base, wherein the drug is dispersed more on the water-insoluble base material involved more than routine skill. That is, as shown by the Examples and the Declaration, the composition of the present invention having more drug adhered on the water-insoluble base material are obtained by specific

processes that are neither taught nor suggested in Suzuki. In addition, there is no teaching in Suzuki that would lead one of ordinary skill in the art to obtain the composition of the present invention using the various methods of the present invention. Therefore, the compositions of the present invention are not obtained by simply optimizing the process of Suzuki.

Therefore, Suzuki does not provide technical motivation for one of ordinary skill in the art to obtain a composition comprising a drug, a water-insoluble base, and a water-soluble base, wherein the drug is dispersed more on the water-insoluble base material, nor would optimizing the process of Suzuki result in the present invention.

Further, the Examiner asserts that Applicants' claims are directed to a product, Applicants have not provided any data comparing the two products and there is no data showing such unexpected results.

In this regard, Applicants wish to point out again that Applicants have provided comparative data of products made by the process of the present invention and made by the process of Suzuki, as discussed above. In addition, Applicants have shown evidence of unexpectedly superior results (e.g., higher C_{max} and larger AUC).

Finally, the Examiner asserts that Applicants' argument that since the drug is freeze-dried with the water-absorbing and water-soluble base material, the drug adheres more to the water-absorbing and water-soluble base (see page 16, first paragraph of the Amendment filed February 19, 2003) is unpersuasive, and the Examiner indicates that facts are preferred over opinion.

It is respectfully submitted that Applicants have provided facts that the drug

adheres more to the water-absorbing and water-soluble base when the drug is freeze-dried with the water-absorbing and water-soluble base material. For example, in the Declaration submitted on February 24, 2000, Applicants submitted photographs showing the adherence of drug to the base materials, and explained how the yellowish color/stain from the drug on the bases corresponds to the amount of drug adhered to the bases. Applicants respectfully direct the Examiner's attention to the Declaration of February 24, 2000 and photographs submitted therewith.

In summary, it is respectfully submitted that the composition of the present invention is different from the composition of Suzuki, and that Suzuki does not provide any technical motivation that would lead one of ordinary skill in the art to be obtain a composition with uneven drug dispersion on the water-absorbing and water-insoluble base material and the water-absorbing and gel-forming base material.

In view of the above, it is respectfully submitted that Suzuki does not teach or suggest the present invention, and withdrawal of the foregoing rejection is respectfully requested.

III. Response to rejection of Claim 58 under 35 U.S.C. § 103(a)

On pages 5-6 of the Office Action, claim 58 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki, and further in view of Makino.

Basically, the Examiner's position is substantially the same as that set forth in the previous Office Actions.

Applicants respectfully submit that the claims should be allowed at least for the reason that Suzuki does not teach or suggest the present invention. In addition,


Applicants submit that Makino does not teach or suggest a powdery composition where a drug is unevenly dispersed on or in a water-absorbing and water-insoluble base material, and therefore, Suzuki in view of Makino fail to teach or suggest the present invention.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Keiko K. Takagi
Registration No. 47,121

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: September 8, 2003 (timely filed since September 7, 2003 is a Sunday)